

REMARKS

Drawing Objections

The drawings filed September 26, 2003 were objected to because Figs. 1 and 2 allegedly contain improper shading; and Figs. 3-11 allegedly contain roughly drawn figure legends, reference numerals, and lead-lines. The Applicants respectfully disagree. However, in an effort to advance the Application to issue, the Applicants have attached fourteen (14) replacement drawing sheets containing amended Figs. 1A, 1B, 2A, 2B, 3, 4, 5, 6, 7, 8, 9A, 9B, 10, and 11. Applicants believe the replacement drawing sheets comply with 37 C.F.R. § 1.121(d), and overcome the objection. Therefore, Applicants respectfully request that the objection to the drawings be withdrawn.

Amendments to the Claims

Claims 2, 3, 4, 5, 7, 9, 10, 14, 16, 17, 18, 20, 23, and 27 have been amended to clarify claim language in accordance with a recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). Applicants respectfully submit that these amendments do not add new matter.

Claim 13 has been amended to depend from claim 12. Applicants respectfully submit that this amendment does not add new matter.

Claim 26 has been amended to depend from claim 25. Applicants respectfully submit that this amendment does not add new matter.

Rejection of Claims

Claims 1-27 are pending in the application, all of which were rejected in the Office action of July 29, 2005. Claims 2, 3, 4, 5, 7, 9, 10, 13, 14, 16, 17, 18, 20, 23, 26 and 27 are amended in this response. Claims 1 and 15 are independent claims, while claims 2-14 and 16-27 depend either directly or indirectly from independent claims 1 and 15, respectively. The Applicants respectfully request reconsideration of the pending claims 1-27, in light of the following remarks.

Claims 1-7, 10, 11, 15-21, and 24 were rejected under 35 U.S.C. 102(e) as being anticipated by Novak (US 2003/0097655 A1). The Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 1, the Applicants respectfully submit that Novak does not teach, suggest, or disclose, for example, a system providing support for user transactions on a media exchange network, the system comprising a television display for consumption of media; a storage for storing media, and having an associated network address; set top box circuitry communicatively coupled to deliver media from the storage to the television display; an interface device for receiving from an authorization device associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry; server software that receives, via a communication network, a request comprising at least one of the associated network address, information identifying the user transaction, and at least a portion of the information for authorizing a user transaction, and responds by enabling the completion of the identified user transaction without divulging the identity of the user to a vendor; and wherein the set top box circuitry comprises media exchange software executable by the set top box to cause pushing of at least one user-constructed media channel comprising a sequence of user selected and scheduled media, to at least one authorized second user of the media exchange network. More specifically, Novak fails to teach, suggest, or disclose server software that responds by enabling the completion of the identified user transaction without divulging the identity of the user to a vendor. The term vendor may be defined as “one that vends”. (see Merriam Webster’s Collegiate Dictionary, Tenth Edition, 2002, page 1306) The term “vend” may be defined as “to sell.” (see Merriam Webster’s Collegiate Dictionary, Tenth Edition, 2002, page 1305) It is clear from Novak that the verification entity is provided the identity of the user (see, e.g., paras. [0025], [0026], [0087], [0090]), and that the verification entity may vend (i.e., sell) a license when no license can be found. (see, e.g., paras. [0091]-[0095]) Novak fails to positively recite the completion of a user transaction without divulging the identity of the user to a vendor. On the contrary, Novak repeatedly states that the user identity is handed to the verification entity, and identifies the verification entity as selling a license to the user. (see, e.g., [0091]-[0095])

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Novak is different from and fails to anticipate the Applicants' invention as set forth in claim 1. The Applicants believe that claim 1 is allowable over Novak. Because claims 2-14 depend from claim 1, Novak is different from and fails to anticipate claims 2-14, as well. Therefore, the Applicants respectfully submit that claims 2-14 are also allowable over the Novak reference. The Applicants respectfully request that the rejection of claims 1-7, 10 and 11 under 35 U.S.C. §102(e), be withdrawn.

Regarding claim 15, the Applicants respectfully submit that Novak does not teach, suggest, or disclose, for example, a system providing support for user transactions on a media exchange network, the system comprising a television display for consumption of media; a storage for storing media; set top box circuitry communicatively coupled to deliver media from the storage to the television display; an interface device for receiving from an authorization device associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry; server software that receives a request via the communication network, and responds by enabling the completion of the user transaction without divulging the identity of the user to a vendor; and wherein the set top box circuitry comprises software executable by the set top box, the software enabling construction and pushing of at least one user selected and scheduled sequence of media, to at least one other authorized user of the media exchange network. More specifically, Novak fails to teach, suggest, or disclose enabling the completion of a user transaction without divulging the identity of the user to a vendor. As discussed above with respect to claim 1, Novak fails to positively recite the completion of a user transaction without divulging the identity of the user to a vendor. On the contrary, Novak repeatedly states that the user identity is handed to the verification entity, and identifies the verification entity as selling a license to the user. (see, e.g., [0091]-[0095]).

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Novak is different from and fails to anticipate the Applicants' invention as set forth in claim 15. The Applicants believe that claim 15 is allowable over Novak. Because claims 16-27 depend from claim 15, Novak is different from and fails to anticipate claims 16-27, as well. Therefore, the Applicants respectfully submit that claims 15-27 are also allowable over the Novak

reference. The Applicants respectfully request that the rejection of claims 15-21 and 24 under 35 U.S.C. §102(e), be withdrawn.

Claims 8, 9, 12-14, 22, 23, and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak (US 2003/0097655 A1) in view of Russell et al. (US 2004/0044627 A1 hereinafter "Russell"). The Applicants respectfully traverse the rejection.

With regard to an obviousness rejection, MPEP 2142 states that in order for a prima facie case of obviousness to be established, three basic criteria must be met, one of which is that the reference or combination of references must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination", and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so'" (citing *In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F. 3d 1308, 50 USPQ 2d. 1161 (Fed Cir. 1999).

Regarding claims 8, 9, 22 and 23, the Applicants respectfully submit that the proposed combination of Novak and Russell does not teach, suggest, or disclose all of the limitations of Applicants' claims 8 and 22 as required by MPEP 2142. In addition, the Applicants respectfully submit that the modification of the Novak reference as proposed in the Office action renders Novak unsatisfactory for its intended purpose. Applicants submit that claims 8 and 9 depend, respectively, from independent claims 1 and 15, and therefore incorporate, respectively, all of the limitations of claims 1 and 15. Applicants' claims 1 and 15 recite "...an interface device for receiving from an authorization device associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry." Applicants' claims 8 and 22 recite the additional limitation "wherein the interface device is communicatively coupled using a wireless coupling mechanism." In the rejection of claims 1 and 15, the Office action alleges that Novak discloses "an interface device (305) for receiving from an authorization device (see Fig. 4: 410) associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry (par.

[0074]).” (Office action, pages 8 and 4) The Applicants respectfully submit that the wireless coupling mechanism of claims 8 and 22 is between the set top box and interface device recited in claims 1 and 15, respectively. The Applicant appreciates recognition by the Examiner that Novak fails to disclose the coupling mechanism being wireless. (Office action, page 9) The elements (305) and (410) of Fig. 410 of Novak are recited as, respectively, a smart card and a smart card reader. (see par. [0087])

The Office action alleges that “[i]t would have been obvious to one of ordinary skill in the art to have modified the system of Novak to have included a remote control of the type and functionality taught by Russell et al. (thereby integrating the smart card reader of Novak in the disclosed remote control of Novak) in order to have provided a self contained, and portable remote control that can be carrier on one’s person (see Russell et al.: par. [0182]).” (Office action, page 12) The Applicants respectfully disagree. In that the Office action has failed to identify the specific teaching of Russell that corresponds to the “remote control of the type and functionality taught by Russell”, the Applicants assume that the “remote control of the type and functionality taught by Russell et al.” is the “personal identifying device” or “PID” (100) illustrated in Fig. 1. The Examiner is respectfully requested to notify the Applicants if this assumption is in error, and to clearly identify the specific teachings of Russell referred to in the Office action.

Russell states that a PID “generally, is a portable device that authenticates that any user of the device is privileged to use the device, plus, is authorized to request that particular actions be taken.” (see, e.g., par. [0053]) Applicants respectfully submit that Russell fails to teach the use of a smart card or that the PID (i.e., a remote control) may act as an interface device for a smart card, let alone that the PID accepts information for authorizing a user transaction from a smart card. To the contrary, Russell teaches that the PID comprises a data input module (140 of Fig. 1) that accepts input from a user, not a smart card, employing a verification input component (156 in Fig. 1) and an identity verification module (150) that comprises an identity data module (152) and a comparator (154) that “...compares the user identity data obtained by the verification input component with at least one set of stored identity data.” (Russell, par. [0175]) Novak also fails to teach a remote control that acts as an interface device for a smart card.

Applicants respectfully submit that modifying the system of Novak to include a PID (i.e., a remote control of the type and functionality taught by Russell et al.) in place of the smart card

reader and remote control of Novak would eliminate the ability to accept smart cards, rendering Novak non-functional in that respect. MPEP §2143.01 states that “[t]he proposed modification cannot render the prior art unsatisfactory for its intended purpose” (MPEP page 2100-131). The MPEP goes on to state that “[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” The Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness as required by MPEP §2142.

Therefore, the Applicants respectfully submit that claims 8 and 22 are allowable over the proposed combination of Novak and Russell for at least the reasons set forth above. Claims 9 and 23 are dependent claims depending, respectively, from claims 8 and 22. Because claims 8 and 22 are allowable over the proposed combination of Novak and Russell, the Applicants assert that dependent claims 9 and 23 are also allowable over the proposed combination of references. Therefore, the Applicants respectfully request that the rejection of claims 8, 9, 22 and 23 under 35 U.S.C. § 103(a) be withdrawn.

Regarding claims 12 and 25, the Applicants respectfully submit that the proposed combination of Novak and Russell does not teach, suggest, or disclose all of the limitations of Applicants’ claims 12 and 25 as required by MPEP 2142. The Applicants respectfully submit that claims 12 and 25 depend, respectively, from claims 11 and 24, and therefore incorporate all of the limitations of claims 12 and 24, respectively. Applicants’ claims 11 and 24 recite “...a remote control communicatively coupled to the set top box circuitry.” Applicants’ respective dependent claims 12 and 25 recite the additional limitation “wherein the remote control comprises an interface device for receiving user transaction authorization information from an authorization device associated with a user, the remote control communicating the user transaction authorization information to the set top box circuitry.” In the rejection of claims 12 and 25, the Office action states that “...the authentication process may require the user (402) to enter **additional** information via the remote control (106) which communicates the user transaction authorization to the set top box circuitry (par. [0089]).” (emphasis added) (Office action page 9). The Applicants appreciate recognition in the Office action that “Novak, however, does not teach that such [additional] information is from an authorization device, per se.” (missing word added). The Office action alleges that “Russell et al. teaches that the PID

comprise [sic] an interface device for receiving user transaction authorization information from an authorization device associated with a user.” (Office action page 11) The Applicants respectfully disagree. In view of the reference to the PID of Russell, and the fact that the Office action fails to identify the specific teaching of Russell that corresponds to the remote control of Applicants’ claims 12 and 25, the Applicants assume that the Office action alleges correspondence between the remote control of claims 12 and 25, and the “personal identifying device” or “PID” (100) of Russell, as illustrated in Fig. 1. The Examiner is respectfully requested to notify the Applicants if this assumption is in error, and to clearly identify the teaching of Russell referred to in the Office action. In the rejection of claims 1 and 15 (from which claims 12 and 25 indirectly depend), the Office action alleges that the “authorization device associated with a user” corresponds to the smart card (410) of Novak. (see response to rejection of claims 1 and 15, above) Novak, however, fails to teach a remote control comprising an interface device for receiving user transaction authorization information from an authorization device (e.g., a smart card) associated with a user. Instead, Novak teaches a remote control (106) communicatively coupled to the set top box, and a separate interface device (305) for interfacing to a smart card (410). (see Figs. 2 and 4, and related text) Applicants respectfully submit that Russell also fails to teach any use of a smart card, or that the PID may act as an interface device for a smart card, let alone that the PID accepts information for authorizing a user transaction from a smart card. To the contrary, Russell teaches that the PID comprises a data input module (140 of Fig. 1) that accepts input from a user, not a smart card, employing a verification input component (156 in Fig. 1) and an identity verification module (150) that comprises an identity data module (152) and a comparator (154) that “...compares the user identity data obtained by the verification input component with at least one set of stored identity data.” The Applicants respectfully submit, therefore, that the Office action has failed to establish a *prima facie* case of obviousness as required by MPEP §2142.

Therefore, the Applicants respectfully submit that claims 8 and 22 are allowable over the proposed combination of Novak and Russell for at least the reasons set forth above. Claims 9 and 23 are dependent claims depending, respectively, from claims 8 and 22. Because claims 8 and 22 are allowable over the proposed combination of Novak and Russell, the Applicants assert that dependent claims 9 and 23 are also allowable over the proposed combination of references.

Therefore, the Applicants respectfully request that the rejection of claims 8, 9, 22 and 23 under 35 U.S.C. § 103(a) be withdrawn.

Regarding amended claim 13, claim 14, amended claim 26 and claim 27, the Applicants respectfully submit that amended claim 13 and claim 14, and amended claim 26 and claim 27 depend either directly from claims 12 and 25, respectively. Claims 12 and 25 are allowable over the proposed combination of references for at least the reasons set forth above. Because claims 13 and 14, and 26 and 27 depend from allowable claims 12 and 25, respectively, Applicant respectfully submits that claims 13, 14, 26 and 27, are allowable as well. Therefore, the Applicants respectfully request that the rejection of claims 13, 14, 26, and 27 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

The Applicants believe that all of claims 1-27 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to contact the undersigned at (312) 775-8000 for an interview.

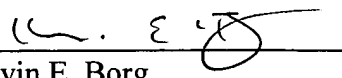
A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

Date: October 28, 2005

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, Illinois 60661
Phone (312) 775-8000
Facsimile (312) 775-8100


Kevin E. Borg
Reg. No. 51,486

AMENDMENTS TO THE DRAWINGS

Fourteen (14) replacement drawing sheets are attached. The attached sheets include changes to Figures 1A, 1B, 2A, 2B, 3, 4, 5, 6, 7, 8, 9A, 9B, 10, and 11.

Figures 1A, 1B, 2A, 2B, 3, 4, 5, 6, 7, 8, 9A, 9B, 10, and 11 have been re-drawn to eliminate improper shading, roughly drawn figure legends, reference numerals, and lead lines, as required by the Office action. No substantive amendments have been made to the figures. The Applicant respectfully submits that these amendments do not add new matter.